

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASARU AKIBA and TOMOYOSHI TSURUFUZI

Appeal No. 1998-2204
Application No. 08/470,432

HEARD: September 12, 2000

Before CALVERT, FRANKFORT, and JENNIFER D. BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 16-18, 26 and 27. Claims 19-25 and 28, the only other claims remaining in this application, have been indicated allowable by the examiner.

BACKGROUND

The appellants' invention relates to a fishing rod through which fishline is laid, comprising a tubular member or rod pipe and a guide means or member attached to the tubular member or rod pipe for introducing the fishline from outside the tubular member or rod pipe to a hollow inner core thereof. The claims are particularly directed to the embodiment illustrated in Figure 11. An understanding of the invention can be derived from a reading of exemplary claims 16 and 26, which appear in the appendix to the appellants' brief.¹

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Viveiros	3,314,186	Apr. 18, 1967
Barnett	4,212,126	Jul. 15, 1980
Cranston	1,259,820	Jan. 12, 1972
(British patent specification)		
Saita et al. (Saita)	1-178373	Dec. 20, 1989 ²
(Japanese unexamined utility model application)		

¹ The copy of claim 16 in the appendix to the appellants' brief is an inaccurate reproduction of the claim of record, in that, in line 9, "mortise" should be "slot" (see Paper No. 4, page 2).

² Our understanding of this reference is derived from the complete copy of the application and translation thereof submitted by the appellants with the brief (Paper No. 15). As indicated from the translation of the abbreviated publication provided by the PTO (copy appended hereto), the date on which the Japanese application was laid open appears to be December 20, 1989, not 1878 as indicated on page 1 of the appellants' translation.

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An additional reference of record relied on by this panel of the Board is:³

Horton et al. (Horton)	5,159,776	Nov. 3, 1992 (filed Jul. 24, 1990)
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The following rejections are before us for review.

Claim 26 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Barnett.

Claims 16, 18 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Saita in view of Cranston.

Claim 17 stands rejected under 35 U.S.C. § 103 as being unpatentable over Saita in view of Cranston and Viveiros.

Reference is made to the brief (Paper No. 15) and the answer (Paper No. 16) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

³ This reference was cited by the examiner in Paper No. 6 and a copy is of record in the application file.

The anticipation rejection

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Claim 26 requires "a relatively soft shock absorbing member" interposed between the rod pipe and fishline guide member "for absorbing shock therebetween." The sleeve 15 of Barnett relied upon by the examiner as meeting this limitation is of "reinforcing material, ideally that of the rod blank sections" provided to compensate for the weakening of the rod due to formation of the opening 10 therein (column 3, lines 5-9). The rod material, and hence the sleeve 15, is ideally formed from glass reinforced plastics material (column 5, lines 17-18). In light of this disclosure, we consider unreasonable the examiner's position, stated on page 5 of the answer, that the sleeve 15 is "a relatively soft shock absorbing member."

In proceedings before it, the PTO applies to the verbiage of claims the broadest **reasonable** meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or

otherwise that may be afforded by the written description contained in the applicant's specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

In this instance, we share the appellants' opinion (brief, page 8) that one of ordinary skill in the art would have understood the term "relatively" as indicating relative hardness of the shock absorbing member as compared to that of either the guide member or the rod pipe and, accordingly, would not have considered the sleeve 15 as disclosed by Barnett to be relatively soft as compared to the rod, which is ideally made from the same material. Further, while it may be true that all materials are inherently capable of absorbing at least a nominal amount of shock, one of ordinary skill in the art would not have considered a glass reinforced plastic sleeve to necessarily be a "shock absorbing member" (akin to the "solid rubber and the like" material disclosed on page 17 of the appellants' specification) as that term is conventionally used in the art and there is no indication in Barnett that the sleeve is either soft or a shock absorbing member.

Therefore, we shall not sustain the examiner's rejection of claim 26.

The obviousness rejections

Independent claim 16 requires, *inter alia*, a tubular member and a guide means comprising a first guide ring at the first (outside) end and a second guide ring at the second (inside) end, wherein the second guide ring is disposed within the hollow core of the tubular member and the first guide ring is coaxial with respect to the second guide ring. We interpret

"coaxial" in the context of this claim as requiring that the first and second rings lie parallel to one another with their centers aligned, such that the "axes" passing through the center of each of the rings in a direction normal to the annular end faces of each of the rings coincide.

As illustrated in Figures 1 and 2 of Saita, the guide member (intermediate through member 41) extends at an angle with respect to the main rod 31 and comprises a protrusion 55 extending inside the inner wall surface of the main rod. However, the first and second ends of the intermediate through member 41 are not parallel with one another, as best seen in Figure 1. Therefore, even assuming Cranston (page 2, lines 3-38) would have suggested to a skilled artisan modification of the Saita fishing rod by providing integral low friction bushes (or rings) at the ends of the intermediate through member to assist free passage of the line, such an artisan would have been directed by the references to locate the first ring flush with the first end of the intermediate through member and the second ring flush with the protrusion 55, thereby leaving the first ring inclined (and thus not "coaxial") with respect to the second ring.

Accordingly, we shall not sustain the examiner's rejection of independent claim 16, or of claims 18 and 27 which depend therefrom.

As Viveiros provides no teaching to overcome the above-noted deficiency of the combination of Saita and Cranston, it follows that we shall also not sustain the examiner's rejection of claim 17 as being unpatentable over Saita in view of Cranston and Viveiros.

NEW GROUNDS OF REJECTION

Pursuant to 37 CFR § 1.196(b), we enter the following new grounds of rejection of claims 16-18 and 27.

Claims 16, 18 and 27 are rejected under the judicially created doctrine of double patenting over claim 4 of the appellants' U.S. Patent No. 5,479,740⁴ in view of Horton and Cranston.

Claim 4 of the appellants' patent recites all of the subject matter of claims 16 and 18 except the particular angular range of 3-20 degrees between the axis of the guide means and the longitudinal axis of the tubular member and the first and second guide rings. To provide an angle of 15 degrees, which falls within the recited range, between the axis of the guide means and the longitudinal axis of the tubular member would have been obvious to one of ordinary skill in the art to minimize the line contact with the interior wall of the tubular member while permitting easy passage of the line into the guide member, as taught by Horton (column 3, lines 25-39). To further provide low friction bushes or rings at the first and second ends of the guide means to assist free passage of the line, as taught by Cranston (page 2, lines 3-38), would also have been obvious to one of ordinary skill in the art. In view of the recitation in claim 4 of the appellants' patent that the first and second ends both lie in planes perpendicular to the

⁴ This patent issued on Application No. 08/193,647, filed February 7, 1994, the parent of the instant application.

single axis of the guide means, it would have been obvious to provide the low friction rings so as to be "coaxial" as interpreted above.

As to claim 27, to integrally form the guide rings and outer member and guide means as a unitary body would have been obvious in view of the suggestion to do so by Cranston (page 2, lines 15-23).

Claim 17 is rejected under the judicially created doctrine of double patenting over claim 4 of the appellants' U.S. Patent No. 5,479,740 in view of Horton and Cranston, as applied above to claim 16, further in view of Viveiros.

Claim 4 of the appellants' patent does not recite a guide means which gradually increases in size from the second end to the first end, as required in claim 17. However, to form the guide means as a funnel which increases in size from the second end to the first end to decrease any loops that may be in the line coming from the reel in an equal and instantaneous manner so that the line flows into the tubular member evenly, as taught by Viveiros (column 2, lines 43-46), would have been obvious to one of ordinary skill in the art of fishing rods.

The double patenting rejections are based on a judicially created doctrine of double patenting grounded in public policy so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent by prohibiting the issuance of the claims in a second patent not patentably distinct from the claims of the first patent. See In re Longi, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985).

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A timely filed terminal disclaimer in compliance with 37 CFR § 1.321(c) may be used to overcome an actual or provisional rejection based on an obviousness type double patenting ground provided the conflicting patent is shown to be commonly owned with this application. See 37 CFR § 1.130(b).

CONCLUSION

To summarize, the decision of the examiner to reject claim 26 under 35 U.S.C. § 102(b) and claims 16-18 and 27 under 35 U.S.C. § 103 is reversed. New rejections of claims 16-18 and 27 are entered pursuant to 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

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(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

IAN A. CALVERT
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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